

REMARKS

By this Amendment, Applicants cancel claim 6 without prejudice or disclaimer of the subject matter thereof, and propose amending claims 1, 7, 8, 15, and 19 for further clarity and to more appropriately define the present invention. No new matter is introduced. Claims 1-4 and 7-20 are pending in this application.

In the Office Action mailed December 8, 2003, the Examiner rejected claims 6 and 8 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. By this Amendment, Applicants cancel claim 6 without prejudice or disclaimer and amend claim 8 for clarity. Accordingly, upon entry of these amendments, the Examiner should withdraw the rejection of claim 8 under 35 U.S.C. § 112, second paragraph.

The Examiner also rejected claims 1-4 and 6-20 under 35 U.S.C. § 103(a) as unpatentable over Saylor et al. (U.S. Patent No. 5,487,139) in view of Tamano et al. (U.S. Patent No. 6,032,157). Applicants respectfully traverse the rejections for at least the following reasons.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed.

2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claim 1 recites a combination including, among other things, "making a first annotation on a first region of the first map; determining a geographic region on the second map corresponding to the first region; and adding a second annotation to the second map at the determined geographic region." Saylor and Tamano, taken alone or in combination, do not disclose or suggest at least these features.

By contrast, Saylor discloses using a vector database to create a vector map that is aligned with a raster map produced from an existing hand-drawn map. Saylor discloses scanning an existing cartographic drawing to create the raster map. See col. 4, lines 51-53. Vector information corresponding to the raster map is received from a vector background database to generate the vector map. See col. 5, lines 15-20. The raster map and the vector map are aligned. See col. 5, lines 29-31. The system retrieves X, Y coordinate information for a power service interruption location, and displays that location so as to appear overlapped on the raster map. See col. 7, lines 40-52. Saylor thus discloses aligning two maps over each other and then displaying a location.

Additionally, the Examiner in making the rejection also cites col. 1, lines 30-50, which discloses using a colored pin or other type of marker to post a location on a paper map. See col. 1, lines 39-41; see also col. 1 lines, 29-31 ("These distribution maps may be large, extending for example from floor to ceiling and wall to wall."). These teachings, however, do not constitute at least "making a first annotation on a first region of the first map; determining a geographic region on the second map corresponding to

the first region; and adding a second annotation to the second map at the determined geographic region," as recited in claim 1.

Nor does Tamano make up for the deficiencies of Saylor. Tamano discloses a system in which a user links two images, such as maps, by choosing a correspondence between objects on the images. The link enables the user to retrieve previously stored attribute information about the corresponding objects. See col. 2, lines 40-52. To link two images, the user views the images and inputs the correspondence "by selecting an object in the second image information." See col. 2, lines 40-52. Therefore, the system of Tamano teaches that the two images contain objects that are present on the two images before any correspondence is determined. See col. 4, lines 6-25. Accordingly, Saylor and Tamano, taken alone or in combination, fail to disclose or suggest claim 1.

Moreover, there is no motivation to combine the references. Saylor discloses aligning maps and then displaying a location. Tamano discloses a system in which a user links two maps by choosing a correspondence between objects on the maps so the user may retrieve previously stored attribute information about the corresponding objects. One of skill in the art would not be motivated to combine Saylor's teachings directed to map alignment with Tamano's disclosure of linking attribute information. In contrast, the cited references teach away from such a combination because Saylor discloses aligning maps, which obviates any need to link attribute information between the already aligned maps. There is thus also no reasonable expectation of success for making the proposed combination. Accordingly, for at least the above reasons, Applicants respectfully request the Examiner to allow claim 1.

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Independent claims 15 and 19 include recitations similar to those of claim 1. For example, claim 15 recites a combination including, among other things, "making a first annotation on a first region of the first map; determining a geographic region on the second map corresponding to the first region; and adding a second annotation to the second map at the determined geographic region." Claim 19 recites a combination including, among other things, "means for making a first annotation on a first region of the first map; means for determining geographic region on the second map corresponding to the first region; and means for adding a second annotation to the second map at the determined geographic region." For at least the same reasons as discussed above, Saylor and Tamano, taken alone or in combination, fail to disclose or suggest claims 15 and 19. Accordingly, Applicants respectfully request the Examiner to allow claims 15 and 19.

Claims 2-4 and 7-14 depend from claim 1. Claims 16-18 depend from claim 15. Claim 20 depends from claim 19. Because Saylor and Tamano, taken alone or in combination, fail to disclose or suggest every element of independent claims 1, 15, and 19, these references also fail to disclose or suggest every element of the dependent claims. Therefore, Applicants respectfully request the Examiner to allow claims 2-4, 7-14, 16-18, and 20.

CONCLUSION

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 1-4 and 7-20 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 7, 8, 15, and 19 do not raise new issues or necessitate the undertaking of any additional search of the art by the

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Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

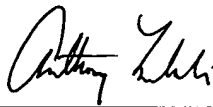
In view of the foregoing remarks, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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